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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/748,941

12/30/2003

Michael Shoen Davis

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EXAMINER

CHEN, VIVIAN

ART UNIT

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1794

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/748,941	Applicant(s) DAVIS ET AL.	
	Examiner Vivian Chen	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008 and 06 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,8-12,14-18,23,27,29,31,39,47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,8-12,14-18,23,27,29,31 and 39, 47-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-5, 7, 13, 19-22, 24-26, 28, 30, 32-38, 40-46 have been cancelled by Applicant.

Priority

1. In response to Applicant's new claim of domestic priority as filed on 4/17/2007:

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The parent applications 10/310,295 (filed 12/5/2002) and 09/908,396 (filed 7/18/2001) and 09/368,708 (filed 8/5/1999) as originally filed does not provide support for a substantial number of the present claims. Therefore:

claims 6, 8-10, 12, 14-18, 27, 31, 39 are deemed to have an effective filing date of 12/30/2003;

claims 11, 23, 29, 47-48 are deemed to have an effective filing date of 08/05/1999.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 6, 8-12, 14, 23, 27, 29, 31, 39, 47-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(a) claims 1-37 of copending Application No. 10/895,522 (US 2006/0017193);
in view of GAGGAR ET AL (US 6,720,386) or Applicant's Admissions.

The copending reference claim multilayer laminates comprising a resorcinol arylate polyester-carbonate copolymer surface layer, at least one intermediate layer, and an inner layer comprising a blend of polycarbonate and acrylonitrile-styrene-acrylate graft copolymer (ASA), and other recited features. Features not specifically recited are obvious and/or well known in the art.

GAGGAR ET AL discloses that commercially available ASA products typically comprise a grafted elastomeric terpolymer comprising acrylate-styrene-acrylonitrile (ASA) dispersed in a matrix of styrene-acrylonitrile (SAN) copolymer. (lines 13-28, col. 1)

Applicant admits that ASA products typically comprise a grafted elastomeric terpolymer comprising acrylate-styrene-acrylonitrile (ASA) dispersed in a matrix of styrene-acrylonitrile (SAN) copolymer. (specification, paragraph [0113])

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize commercially available ASA products comprising a blend of

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grafted ASA terpolymer and SAN copolymer as the ASA component in the laminates claimed in the copending application in order to obtain durable, attractive laminates. It would have been obvious to use commercially available stabilizers (claims 11-12) in order to improve the durability and environmental resistance of the underlying PC/ASA layer. One of ordinary skill in the art would have selected the melt flow properties of the inner layer (claim 14) in order to optimize compatibility in melt processing and multilayer film forming operations. Regarding claim 27, the use of vacuum forming is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). One of ordinary skill in the art would have utilized known structural materials (e.g., polyurethane foams) (claim 31) as the substrate for the laminates of the copending Application in order to form lightweight products with good environmental stability. One of ordinary skill in the art would have used conventional molding and finishing techniques in order to obtain a high quality finish (claim 39) as desired for specific applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 11-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (a) claims 1-37 of copending Application No. 10/895,522 (US 2006/0017193);
in view of GAGGAR ET AL (US 6,720,386) or Applicant's Admissions,
as applied to claim 1 above;
and further in view of HASHIMOTO ET AL (US 6,780,917).

HASHIMOTO ET AL discloses that it is well known in the art to incorporate alkylthioester-based stabilizers as recited in claim 12 in polycarbonate resins in order to improve durability and use-life. (line 51, col. 23 to line 10, col. 24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize commercially available stabilizers known to be suitable for use in polycarbonate-based compositions in order to improve the durability and environmental resistance of a PC/ASA blend layer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 31 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (a) claims 1-37 of copending Application No. 10/895,522 (US 2006/0017193);

in view of GAGGAR ET AL (US 6,720,386) or Applicant's Admissions,
as applied to claim 1 above;
and further in view of BURKE (US 5,080,950).

BURKE discloses that it is well known in the art to form structural articles from polyurethane foam, wherein the foam is covered by a protective layer. (Abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize conventional polyurethane foam materials as the substrate for the films claimed in the copending Application in order to form a durable, lightweight article.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. Claims 6, 8-10, 12, 14-18, 27, 31, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

BRUNELLE ET AL (US 6,306,507) or BRUNELLE ET AL (US 6,265,522) or WO 00/61664 (WO '664);

in view of GAGGAR ET AL (US 6,720,386) or Applicant's Admissions.

BRUNELLE ET AL references and WO '664 each disclose multilayer laminates comprising a resorcinol arylate polyester-carbonate copolymer surface layer having a typical thickness of 2-2500 microns, at least one intermediate layer (e.g., polycarbonate, polymethylmethacrylate (PMMA), and blends thereof), and an inner layer comprising a polycarbonate, acrylonitrile-styrene-acrylate graft copolymer (ASA), polymethyl methacrylate

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(PMMA), and blends thereof (e.g., PC/ASA blends), wherein the laminate is optionally further applied to a thermoplastic or thermoset substrate layer. The laminate is formed by a variety of conventional methods such as coextrusion, and is suitable for automotive components and panels, as well as for forming coated foamed articles. (see entire documents)

GAGGAR ET AL discloses that commercially available ASA products typically comprise a grafted elastomeric terpolymer comprising acrylate-styrene-acrylonitrile (ASA) dispersed in a matrix of styrene-acrylonitrile (SAN) copolymer. (lines 13-28, col. 1)

Applicant admits that ASA products typically comprise a grafted elastomeric terpolymer comprising acrylate-styrene-acrylonitrile (ASA) dispersed in a matrix of styrene-acrylonitrile (SAN) copolymer. (specification, paragraph [0113])

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize commercially available ASA products comprising a blend of grafted ASA terpolymer and SAN copolymer as the ASA component in the PC/ASA blends usable as layers in the laminates disclosed in BRUNELLE references in order to obtain durable, attractive laminates which can further be used as cladding or surface layers for other substrate materials. It would have been obvious to use commercially available stabilizers (claims 11-12) in order to improve the durability and environmental resistance of the underlying PC/ASA layer. One of ordinary skill in the art would have selected the melt flow properties of the inner layer (claim 14) in order to optimize compatibility in melt processing and multilayer film forming operations. It would have been obvious to incorporate additional intermediate functional layers (claim 16-18) in order to optimize specific mechanical properties, enhance adhesion and/or to obtain specific color or visual effects. One of ordinary skill in the art would have used

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conventional foam-forming materials such as polyurethane (claim 31) as a substrate in order to obtain useful coated foam articles. Regarding claim 27, the method of forming is a product-by-process limitation and is not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. ***The patentability of a product does not depend on its method of production.*** If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." [emphasis added] *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing substantially identical is found, the burden shifts to applicant to show a ***unobvious*** difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993). One of ordinary skill in the art would have used conventional molding and finishing techniques in order to obtain a high quality finish (claim 39) as desired for specific applications.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over:

BRUNELLE ET AL (US 6,306,507) or BRUNELLE ET AL (US 6,265,522) or WO 00/61664;

in view of GAGGAR ET AL (US 6,720,386) or Applicant's Admissions;

as applied to claim 1 above;

and further in view of HASHIMOTO ET AL (US 6,780,917).

HASHIMOTO ET AL discloses that it is well known in the art to incorporate alkylthioester-based stabilizers as recited in claim 12 in polycarbonate resins in order to improve durability and use-life. (line 51, col. 23 to line 10, col. 24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize commercially available stabilizers known to be suitable for use in polycarbonate-based compositions in order to improve the durability and environmental resistance of a PC/ASA blend layer.

7. Claims 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

BRUNELLE ET AL (US 6,306,507) or BRUNELLE ET AL (US 6,265,522) or WO 00/61664;

in view of GAGGAR ET AL (US 6,720,386) or Applicant's Admissions;

as applied to claim 1 above;

and further in view of BURKE (US 5,080,950).

BURKE discloses that it is well known in the art to form structural articles from polyurethane foam, wherein the foam is covered by a protective layer. (Abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize conventional polyurethane foam materials as the substrate for the films disclosed in the BRUNELLE ET AL and WO '664 references in order to form a durable, lightweight article.

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8. The rejections with respect to claims 11, 23, 29, 47-48 under 35 U.S.C. 103(a) as set forth in the previous Office Action has been withdrawn in view of Applicant's revised claim of domestic priority -- claims 11, 23, 29, 47-48 are deemed to have an effective filing date of 08/05/1999.

Response to Arguments

1. Applicant's arguments filed 4/17/2007 and 8/6/2007 have been fully considered but they are not persuasive.

(A) Applicant argues that the outstanding obviousness-type double patenting rejections should be withdrawn since none of the cited copending Applications nor the present Application has been patented. However, as noted above, the double patenting rejections are clearly stated as being provisional. Such provisional double patenting rejections are clearly permissible even when none of the involved Applications have yet been patented. See MPEP 804(I)(B).

(B) Applicant argues that BRUNELLE ET AL '507 and '522 and WO '664 are not proper 35 U.S.C. 103 references against the present application. However, as stated above, the parent applications 10/310,295 (filed 12/5/2002) and 09/908,396 (filed 7/18/2001) and 09/368,708 (filed 8/5/1999) as originally filed does not provide support for a substantial number of the present claims. Since claims 6, 8-10, 12, 14-18, 27, 31, 39 are deemed to have an effective filing date of 12/30/2003, the BRUNELLE ET AL '507 and '522 and WO '664 references qualify as prior art against the above claims under the provisions of 35 U.S.C.102(b). If Applicant contends that the parent applications provide support for the above listed claims, the

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Applicant should point out with specificity the portions of each parent application which provide support for each claim in order to establish the alleged effective filing date for each claim.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 2, 2008

/Vivian Chen/

Primary Examiner, Art Unit 1794